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OFFICE OF PETITIONS

In re Patent No. 7,083,811
Jung et al.
Issue Date: August 1, 2006
Application No. 10/053,620
Filed: January 24, 2002
Attorney Docket No.
05823.0199.01000

:
: DECISION ON
: APPLICATION FOR
: PATENT TERM ADJUSTMENT
: and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:

This is in response to the paper styled NOTICE OF SUSPECTED ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT, filed May 9, 2006. Pursuant to their duty of good faith and candor to the Office, patentees disclose that the initial determination of patent term adjustment under 35 U.S.C. 154(b) received with the notice of allowance may be shorter than 127 days.

The request for review of the patent term adjustment is **GRANTED**.

Prior to a decision being rendered in response to this letter, on August 1, 2006, the above-identified application matured into U.S. Patent No. 7,083,811 with a revised patent term adjustment of 42 days.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of sixteen (16) days.

On February 9, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 127 days. On May 9, 2006, with payment of the issue fee, patentees filed this letter.

Patentees' comments have been considered and found persuasive to the extent indicated. As noted, the patent term adjustment does properly take into account a 98-day delay by the Office in mailing a first Office action on the merits and an 84-day delay by applicants in responding. However, the entry of a period of reduction of 180 days, pursuant to \$1.704(b), for applicant taking until December 22, 2004 to file a request for continued examination (RCE) in response to the final rejection mailed March 25, 2004 is incorrect. Rather, given the abandonment of the application for failure to timely respond to the final rejection, pursuant to \$1.704(c)(3), the period of reduction is 236 days.

37 CFR 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or
(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

In this instance, the application became abandoned effective June 26, 2004. The RCE filed December 22, 2004 was filed with the petition to revive. By decision mailed February 16, 2005, the petition was granted. Accordingly, the period of reduction is 236 days counting the number of days beginning on the date of abandonment, June 26, 2004, and ending on the earlier date of mailing of the decision granting the petition, February 16, 2005.

As for the period of adjustment for the Office taking in excess of three years to issue the patent, the Office properly did not accord an additional period of adjustment for Office delay in issuing the patent. If an application is entitled to an

adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, no periods consumed by abandonment of the application will be considered. Moreover, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

In this instance, the patent issued 3 years and 554 days after the actual filing date of the application. However, the application was abandoned for 236 days. So only (554 - 236) 218 days can be considered as Office delay in issuing the patent pursuant to §1.702(b). The total of 336 days of Office delay attributable to grounds specified in §§ 1.702(a)(1) and (2) overlaps with the 218 days considered attributable to the delay in the issuance of the patent. Thus, the period of adjustment for Office delay cannot exceed the actual number of days of delay of 336 days. Patentees are not entitled to any additional days of patent term for Office delay in issuing the patent.

One further correction is required. A review of the record confirms that a period of reduction of 85 days was entered for the filing of this paper. 37 CFR § 1.704(e) provides that:

Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

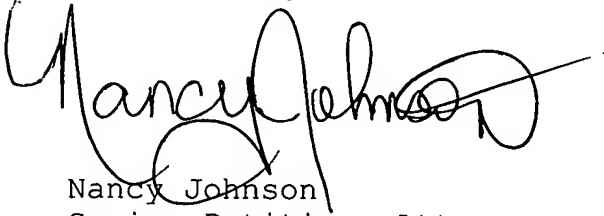
Accordingly, the period of reduction of 85 days is being removed.

In view thereof, the patent should have issued with a revised patent term adjustment of sixteen **(16)** days.

The \$200.00 fee set forth in 37 CFR 1.18(e) has been received. No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by sixteen (16) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,083,811 B2
DATED : August 1, 2006
INVENTOR(S) : Jung et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (42) days

Delete the phrase "by 42" and insert – by 16 days--